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EXAMINER

KUBELIK, ANNE R

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| ART UNIT | PAPER NUMBER |
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1638

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| MAIL DATE | DELIVERY MODE |
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09/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,028

Applicant(s)

WILLIAMS ET AL.

Examiner

Anne R. Kubelik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-15 and 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15, 17, 18, 23-27 and 30 is/are allowed.
- 6) ☒ Claim(s) 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 19-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 and 17-30 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The terminal disclaimer filed on 25 July 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,759,578 has been reviewed and is accepted. The terminal disclaimer has been recorded.
4. The rejection of claim 16 under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is obviated by Applicant's cancellation of the claim.
5. The rejection of claim 16 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Hoffbeck (1998, US Patent 5,723,723) is obviated by Applicant's cancellation of the claim.
6. The rejection of claims 1-30 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,759,578 is withdrawn in light of Applicant's filing a Terminal Disclaimer.

Claim Objections

7. Claims 19-22 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

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claim(s) in independent form. The claimed plants do not have all the characteristics of the plant of claim 11; thus, the claims do not properly depend from the parent claim. The objection is repeated for the reasons of record as set forth in the Office action mailed 30 April 2007.

Applicant's arguments filed 25 July 2007 have been fully considered but they are not persuasive.

Applicant urges that the plants are the maize plant of claim 11 with additional limitations (response pg 7).

This is not found persuasive because the maize plant of claim 11 has all the physiological and morphological characteristics of inbred line PH6ME. The plants of claims 19-22, because they have additional characteristics, not present in the maize plant of claim 11, cannot have all the physiological and morphological characteristics of inbred line PH6ME, and thus cannot further limit claim 11. For example, the plant of claim 22 does not have waxy starch, but the plant of claim 22 can have waxy starch; thus, claim 22 is broader than claim 1

Applicant urges that examiners were told these claims were in proper form (response pg 7-8).

This is not found persuasive because there is no exception in 37CFR 1.75(c) for plants, and examiners have not been told to ignore the rules.

Claim Rejections - 35 USC § 112

8. Claims 28-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections. The rejection is repeated for the

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reasons of record as set forth in the Office action mailed 30 April 2007. Applicant's arguments filed 25 July 2007 have been fully considered but they are not persuasive.

Claims 28-29 are indefinite because there are no clear positive method steps. The method step "employing the maize plant" in claim 28 does not recite clearly defined positive method steps. The improper Markush group "using one or more plant breeding techniques selected from the group consisting of ..." renders claim 29 indefinite, since it is unclear how many techniques would be used and in what combinations. Again, the method steps are not clearly defined. For example, it is uncertain for each of the recited breeding techniques what steps they would be comprised of, how many generations of crosses would be incorporated in the method, and what parent plants would be used for each cross.

Applicant urges that the claims have been amended and the claims have been allowed in other cases (response pg 9).

This is not found persuasive. The examiner cannot discuss any other case. The amendment does not overcome the rejection because there are no clear positive method steps.

9. Claims 1-15, 17-18, 23-27 and 30 are allowed.

10. Claims 28-29 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

11. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

The central fax number for official correspondence is (571) 273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne Kubelik, Ph.D.
September 20, 2007

/Anne Kubelik/
Primary Examiner